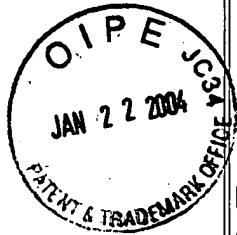


Image



PATENT
Attorney Docket No. 06028.0016-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re National Stage of International)
Application No. PCT/FR99/03245 of:)
)
Hervé ANDREAN et al.) Group Art Unit: 1751
)
Application No.: 09/622,665) Examiner: E. Elhilo
)
PCT Filed: December 22, 1999)
)
Filed: August 22, 2000)
)
For: DYEING METHOD USING A)
SPECIFIC ACTIVE METHYLENE)
COMPOUND AND A COMPOUND)
SELECTED AMONG A SPECIFIC)
ALDEHYDE, A SPECIFIC KETONE, A)
QUINONE AND A DI-IMINO-)
ISOINDOLINE OR 3-AMINO-)
ISOINDOLONE DERIVATIVE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

In response to the Office Action dated December 22, 2003, Applicants respectfully requests reconsideration of this application in view of the following remarks.

In the Office Action, the Examiner requires election under 35 U.S.C. § 121 of one species of each of the following:

(A) the compounds having formulae (I), (II), (III), (IV), (V), (VI), (VII), (VIII), (IX), (X), (XI), (XII), (XIII), (XIV), (XV), (XVI), and (XVII); and

(B) the compounds of aldehydes, ketones, quinones, diminoisoindoline derivatives, and 3-aminoisoindolone derivatives.

Office Action at p. 2.

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According to the Examiner, the species listed above do not relate to a single general inventive concept under the PCT Rules because the present claims are drawn to a "very wide variety of compounds/products/devices/methods which do not relate to a single general invention" and "lack the same or corresponding technical features." Office Action at p. 3.

Applicants respectfully disagree with the election requirement. However, to be fully responsive, Applicants elect, with traverse, the following species:

(A) a compound of formula (VIII); and

(B) ketones.

The pending claims which read on the elected species are claims 17-20, 28, 39, 40, 42-53, 56, 57, 63, 74, 75, and 77-100.

With respect to the Examiner's allegation of a lack of "same or corresponding technical features," Applicants disagree for at least the following reasons. First, all of the claims are drawn to a process for dyeing keratin fibers by applying a composition comprising (a) at least one compound comprising at least one active methylene group as claimed (chosen from compounds of formulas (I) to (XVII)) and (b) at least one compound chosen from aldehydes, ketones, quinones, diminoisoindoline derivatives, and 3-aminoisoindolone derivatives as claimed.

Second, the M.P.E.P. instructs as follows:

When making a lack of unity of invention requirement, . . . explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

M.P.E.P. § 1893.03(d) (emphasis added).

In the present case, the Examiner has not explained why there is no single general inventive concept, nor has the Examiner specifically described the unique special technical feature in each species. Rather, the Examiner merely concludes that a wide variety of compounds/products/devices/methods are covered by the claims and assumes that these cannot relate to a single general invention. The Examiner's rationale is simply insufficient to support his position.

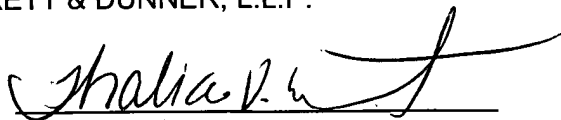
Finally, Applicants respectfully request that the full scope of the claimed invention be examined in this application. If the Examiner chooses to maintain the election requirement, however, and the elected species is found to be allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to the non-elected species, as is the duty of the Examiner according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

In view of the foregoing remarks, Applicants believe the election requirement to be in error, and respectfully request that the requirement be withdrawn.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Thalia V. Warnement
Reg. No. 39,064

Dated: January 22, 2004

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